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May 7, 2009

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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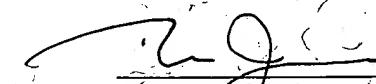
In Re Application of: **Parmelee, et al.**
Serial No.: **09/683,943**
Confirm. No.: **5493**
Filed: **March 5, 2002**
For: **Automated Transaction System
Digital Signature System And Method**
Docket: **D-1154 R2**

Art Unit 2133
Examiner
Nadia Khoshnoodi

Sir:

Please find attached Applicants' Request for Rehearing pursuant to 37 C.F.R. § 41.52 concerning the above-referenced Application.

Respectfully submitted,



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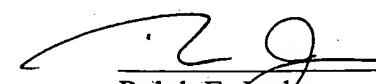
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D-1154 R2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 41.52

Sir:

The Appellants hereby submit their Request for Rehearing pursuant to 37 C.F.R. § 41.52 concerning the above-referenced Application. The Request for Rehearing is in response to the Decision of the Board of Patent Appeals and Interferences in Appeal No. 2008-2907 dated March 19, 2009 ("Decision").

**Statement of Points Believed to Have Been
Misapprehended or Overlooked by the Board**

The Board affirmed the rejections of claims 1-41 based on the finding of “ample support for those portions of the Wheeler published application which were relied upon in the rejection to entitle those portions of the published application to the filing date of the provisional application” (Decision, page 6, lines 11-14). Appellants respectfully submit that this finding is not supported in the Decision, the Examiner’s Answer or any other part of the record.

As acknowledged by the Board, the Wheeler Provisional (US 60/223,076) is a collection of several unconnected e-mail communications. These e-mail communications are significantly dissimilar to the organization and content to the subject matter in the Wheeler Publication (US2002/0026575). Also the portions of the Wheeler Publication used to support the rejections include substantial amounts of new material, not present in the Wheeler Provisional. Thus Appellants respectfully submit that the specific language in the Wheeler Publication is substantively materially different from the specific language in the Wheeler Provisional. The Wheeler Publication also contains subject matter not disclosed in the Wheeler Provisional. Because the Wheeler Publication was filed after Appellants’ priority application, the significant amount of new matter in the Wheeler Publication does not constitute prior art material. It is submitted that the Board committed error by relying on portions of the Wheeler Publication which include new matter not found in the Wheeler Provisional to affirm obviousness with respect to Appellants’ claims. Further by improperly relying on the non-prior art Wheeler Publication, the Board based its decision on improper hindsight rather than actual prior art evidence.

The Decision relied on *Ex parte Yamaguchi*, clip op. at 15 (BPAI Aug. 29, 2008) to support the proposition that “when the Examiner’s factual findings that both documents (published application and provisional application) clearly shows the same subject matter as applied in the rejection, then the Examiner has shifted the burden to Appellants to show such a factual finding is in error.” Thus, in order to shift the burden to Appellants according to *Ex parte Yamaguchi*, the provisional must **clearly show the same subject matter as applied in the rejection**. This is not the case with the present rejections. For example, in table 1 of *Ex parte Yamaguchi*, the Office demonstrated that the formal Figures 2, 3 and 7 of the published application (that were relied on to support the rejection) clearly corresponded to the same informal Figures 2, 3 and 7 of the provisional application. Thus in *Yamaguchi* there was no risk of new matter being improperly relied on as prior art subject matter.

In contrast, the portions of the Wheeler Publication relied on by the Board to sustain the rejections of Appellants’ claims are not clearly shown in the Wheeler Provisional. The Wheeler Provisional is a set of unconnected e-mails that do not clearly show all of the same subject matter as the Wheeler Publication. Rather, the portions of the Wheeler Publication relied upon by the Board in its decision include significant amounts of non-prior art new matter not found in the Wheeler Provisional. On this basis, reversal of the rejections of all of the claims is respectfully requested.

For example, with respect to Appellants’ claim 5, the Examiner supported the rejection based at least in part on paragraphs [0190] of the Wheeler Publication. The Examiner asserted in his Answer on page 7, that lines 1-8 of paragraph [0190] are supported by page 6 of the “aadsstraw” portion and pages 1-2 of the “aadsbrnd” portion of the Wheeler Provisional.

Appellants respectfully disagree.

Page 6 of the “aadsstraw” portion of the Wheeler Provisional discusses “Replay Attack” and “Random Number Requirements.”

Pages 1-2 of the “aadsbrnd” portion of the Wheeler Provisional discusses chip features such as SHA-1, key pairs, signatures, and PINs.

Appellants respectfully submit that these referenced or “correlated” portions of the Wheeler Provisional do not provide “clear” support (as required under *Ex parte Yamaguchi*) for lines 1-8 of paragraph [0190] of the Wheeler Publication which states:

“The message then is transmitted (Step 808) to the card 650 for digital signing by the account holder 602. In this regard, upon receipt of data representing the message, the card 650 originates (Step 810) a digital signature for the message by first calculating a hash value for the data and then encrypting the hash value using the private key retained within the card 650. The card 650 then outputs (Step 812) the digital signature to the ATM machine 660, which then transmits (Step 814) the message and the digital signature therefor in an EC to the financial institution 612,”

Nowhere do the referenced portions of the Wheeler Provisional disclose anything to do with an ATM, outputting a digital signature to an ATM, or an ATM that tracking a message and the digital signature in an EC to a financial institution.

Only by erroneously imputing to the Wheeler Provisional features not found therein and through improper hindsight can the Office assert that lines 1-8 of paragraph [0190] of the Wheeler Publication are clearly supported by the “correlated” portions of the Wheeler Provisional. Further, based on unconnected lists of features found in unconnected e-mail

messages included in the Wheeler Provisional, it is not reasonable to assert that the Wheeler Provisional enables one of ordinary skill in the art (without undue experimentation) to predictably produce the subject matter of lines 1-8 of paragraph [0190] of the Wheeler Publication that were relied upon to support the rejection of claim 5. Thus the assertion in the Decision on page 7, lines 7-8, that “We find the Examiner’s correlations to be well-founded and supported by substantial evidence.” is not supported by the evidence of record. The record plainly shows this finding to be erroneous.

In addition, with respect to Appellants’ claim 5 nowhere does the Wheeler Provisional (even in combination with the other applied art) include Appellants’ recited claim features of a computer processor that is operative to access a private key associated with a digital safe deposit account (stored in a data store with a plurality of other digital safe deposit accounts) responsive to a message received from an ATM; which message received from the ATM includes a financial account number that corresponds to the financial account number associated with the digital safe deposit account; and which accessed private key is used to digitally sign an electronic document responsive to the ATM. The Office has not made a showing of *prima facie* obviousness with respect to claim 5. Further, the Office has not provided any reason or any other rationale as to why one of ordinary skill in the art would modify and/or combine the Wheeler Provisional, Cohen, or any of the other applied art to produce the recited subject matter. It is submitted that the rejection of Appellants’ claim 5 is improper and reversal of the rejection of claim 5 is respectfully requested.

Reversal of all of the rejections is respectfully requested on the grounds that the Office has not established a “clear showing” that the Wheeler Provisional supports the subject matter of

the Wheeler Publication which was the basis for rejecting Appellants' claims. Appellants respectfully submit that the text of the Wheeler Provisional and the Wheeler Publication are too dissimilar (as shown above) to satisfy the requirements of a "a clear showing" of correspondence between the disclosures of Wheeler Provisional and the Wheeler Publication as is required to sustain the rejections. Appellants have shown (via the example with respect to claim 5) that non-prior art new matter added to the Wheeler Publication was used to improperly reject Appellants' claims.

To eliminate the improper imputation to the Wheeler Provisional of subject matter it does not teach, as well as improper hindsight resulting from reliance on non-prior art subject matter in the Wheeler Publication, Appellants respectfully request that the Board reverse the rejections and remand the Application to the Examiner. Applicants further request that the remand direct the Examiner to present rejections that rely on the filing date of the Wheeler Provisional with direct citations to the actual language of the Wheeler Provisional, rather than citations to the much different Wheeler Publication, which includes substantial non-prior art subject matter.

Alternatively, if the Board still contends that the Wheeler Publication (filed after Appellants' priority date) is fully supported by the Wheeler Provisional, then (in order to complete the record prior to Appeal to the Court of Appeals for the Federal Circuit), Appellants respectfully request that the Board carry out an analysis (as done in *Ex parte Yamaguchi*) which explains how the clearly dissimilar referenced portions of the Wheeler Provisional "**clearly show**" all of the corresponding subject matter in the Wheeler Publication relied on to support the rejections of Appellants' claims.

For example with respect to Appellants' claim 5 (which was not discussed in the Decision), Appellants' ask the Board to explain for the Court how the unconnected and unrelated page 6 of the "aadsstraw" portion and pages 1-2 of the "aadsbrnd" portion of the Wheeler Provisional **clearly show all of the same subject matter** as applied from paragraph [190] of the Wheeler Publication to reject claim 5 (e.g., the recited features of outputting a digital signature to an ATM, and an ATM that transmits a message and the digital signature in an EC to a financial institution). Further Appellants further respectfully ask where any of these Wheeler references in combination with the other applied art show the recited feature that: **the computer processor is operative to access the private key associated with the one digital safe deposit account responsive to a message received from the at least one ATM which includes a financial account number that corresponds to the financial account number associated with the one digital safe deposit account?** Further, Appellants ask for an explanation in the record of what reason one of ordinary skill in the art would have to modify the teachings of the Wheeler Provisional and combine such modified features with features of the other applied art to correspond to the recited subject matter of Appellants' claim 5?

Also, for example, with regard to Appellants' claim 20, how do the unconnected and unrelated referenced pages 1-3 of the "aadsstraw" portion and page 6 of the "Rachip" portion of the Wheeler Provisional **clearly show all of the same subject matter** as applied from paragraph [0113] of the Wheeler Publication to support the rejection of claim 20? The "Rachip" portion discusses a public key that is registered in a "database," but nowhere does the Wheeler Provisional teach that this "database" corresponds to an "account" with an account number "(acctID)" as stated in the (non-prior art) Wheeler Publication. Further nowhere does the

Wheeler Provisional disclose that its described “database” or “card” includes a private key associated with a financial account number as recited in Appellants’ claim 20. Although the “aadsbrnd” portion of the Wheeler Provisional discusses “viewing what was signed,” nowhere does the Wheeler Provisional or any of the other applied art, teach viewing an electronic document to be signed on an ATM or on any other device from which a financial account number is received. Nowhere has the Office shown in prior art of record (i.e. prior art not contaminated with the non-prior art portions of the Wheeler Publication) the recited features of: **receiving a financial account number from an automated transaction machine; accessing a private key associated with the financial account number; and enabling an electronic document displayed by the automated transaction machine to be digitally signed with the private key.** Further, what reason would one of ordinary skill in the art have to modify the Wheeler Provisional and combine such modified features with features of the other applied art to produce the recited subject matter? None has been provided in the record. Reversal of the rejection of Appellants’ claim 20 is respectfully requested.

Also, for example, with regard to Appellants’ claim 23, how do the referenced pages 3-6 of the “aadsstraw” portion of the Wheeler Provisional **clearly show all of the same subject matter** as applied from paragraph [0170] of the Wheeler Publication to support the rejection of claim 23? Page 6 of the “aadsstraw” portion of the Wheeler Provisional discusses a “message,” but nowhere does this portion disclose anything to do with “financial transactions in accordance with ISO Standard 8583” as discussed in paragraph [0170] of the Wheeler Publication. Nowhere has the Office shown prior art of record (i.e. prior art not contaminated with the non-prior art portions of the Wheeler Publication) which shows the recited element of: **storing a**

digitally signed copy of the electronic document in a digital safe deposit account in association with the financial account number. Further, what reason would one of ordinary skill in the art have to modify features of the Wheeler Provisional and combine such features with features of the other applied art to produce the recited subject matter? None has been provided in the record. Reversal of the rejection of Appellants' claim 23 is respectfully requested.

Appellants also respectfully request reversal because the Office has improperly based rejections on the Wheeler Provisional. To qualify as a provisional patent application under 35 U.S.C. § 119(e) a filing is required to satisfy the written description, enablement and best mode requirements of 35 U.S.C. § 112, paragraph 1. The fact that the Office has been required to rely on the (non-prior art) Wheeler Publication rather than the Wheeler Provisional in presenting rejections constitutes an admission by the Office that the Wheeler Provisional does not provide a sufficient written description to support the rejections. As the Wheeler Provisional does not satisfy the statutory requirements of § 119(e), it does not constitute citable prior art against Appellants' application.

Applicants respectfully submit that the rejections should be reversed because the rejections rely on the date of the Wheeler Provisional for features the Wheeler Provisional does not teach, and further because the Wheeler Provisional does not meet the written description requirements of 35 U.S.C. § 112 paragraph 1. Failure of the Board to reverse on this basis will constitute a decision by the Office that the Wheeler Provisional satisfies the requirements of § 112 paragraph 1, and that the Office is now prepared to accept and issue patents which have the glaring defects in the disclosure of the Wheeler Provisional.

CONCLUSION

Appellants have presented herein points believed to have been misapprehended or overlooked by the Board in its Decision. Each of Appellants' pending claims specifically recites elements, relationships and steps that are neither disclosed nor suggested in any of the applied prior art. The record is devoid of any teaching, suggestion, or motivation, or any other reason or rationale for one of ordinary skill in the art for producing the recited invention. The Decision is not supported by evidence that establishes that the Wheeler Provisional clearly shows all of the referenced subject matter cited in the Wheeler Publication as a basis to reject all of the claims. Rather, Appellants have shown that the Wheeler Provisional lacks the subject matter relied on for the rejections. Furthermore, the Wheeler Provisional does not qualify as prior art as it fails to meet statutory requirements for a provisional patent application, and the Wheeler Publication does not qualify as prior art because it was filed after Appellants' effective filing date.

Reconsideration and reversal of all of the rejections is respectfully requested.

Respectfully submitted,



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